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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Atty. Docket: SOLEM=3A

In re Application of:) Art Unit: 3738
Jan Otto Solem et al) Examiner: D. Nguyen
Appln. No.: 09/775,677) Washington, D.C.
Filed: February 5, 2001) October 24, 2001
For: METHOD AND DEVICE FOR)
TREATMENT OF MITRAL)
INSUFFICIENCY) BY HAND-CARRYING

REQUEST FOR INTERFERENCE UNDER 37 C.F.R. §1.604

Honorable Commissioner for Patents
Washington, D.C. 20231

Sir:

Pursuant to 37 C.F.R. §1.604, applicants hereby request that an interference be declared between the present application and one or more copending applications of another. Applicants hereby comply with the requirements of 37 C.F.R. §1.604(a)(1)-(3) as follows:

I. Proposed Count And Identification Of Claim

Corresponding Thereto (37 C.F.R. §1.604(a)(1))

Applicants respectfully present the following proposed counts:

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TC 3700 MAIL ROOM

COUNT 1:

A medical device for remodeling a mitral valve annulus adjacent to the coronary sinus in a patient, comprising:

an elongated body extending between a proximal end and a distal end, and that is adjustable between a first configuration having a first shape such that the elongate body is adapted to be delivered at least in part into the coronary sinus and a second configuration having a second shape such that the elongate body is adapted to exert a force from within the coronary sinus onto the mitral valve annulus in order to remodel the mitral valve annulus when the elongate body is adjusted to the second configuration.

COUNT 2:

A method of reducing mitral annulus diameter, comprising

transluminally advancing a prosthesis into the coronary sinus; and

deploying at least a portion of the prosthesis within the coronary sinus to restrain expansion of the mitral annulus.

Applicants hereby identify at least claim 22 of the present application as corresponding exactly to proposed Count

1. Applicants hereby identify at least claim 53 of the present application as corresponding exactly to proposed Count

2. As 37 C.F.R. §1.604(a)(1) requires only that applicants identify at least one claim in its application that corresponds to a proposed count, the present identification of claim 22 as corresponding to Count 1 and claim 53 as corresponding to Count 2 is made without prejudice toward the identification of additional claims which correspond to the counts once the interference is declared.

II. Identification of Other Applications and Claims Therein which Correspond to the Proposed Counts (37 C.F.R. §1.604(a)(2))

The other applications with which the present applicants desire to have an interference declared is application no. 09/494,233 (the '233 application) filed January 31, 2000, application no. 09/909,193 (the '193 application), which is a divisional of the '233 application, as well as any U.S. national stage application which has been (or will be) filed based on international application no. PCT/US01/02823 (the '823 international application) filed January 29, 2001, designating the United States. The '823 international application was published as international

publication no. WO 01/54618 (the '618 publication). The publication discloses that the '823 international application claims priority from the '233 application. Applicants were able to determine from the PTO, pursuant to 37 C.F.R. §1.14(b) (2) and (b) (4) that the '193 application was filed as a divisional of the '233 application.

Applicants do not have access to the '233 or '193 applications or any application which is the national stage of the '823 international application. However, applicants assume that the claims of such applications are identical to or are not patentably distinct from the claims of the '823 international application (as published in the '618 publication). Claim 2 of the '823 international application corresponds exactly to proposed Count 1, and claim 55 of the '823 international application corresponds exactly to Count 2. Furthermore, all of claims 1-42 and 80-82 of the '823 international application correspond substantially to proposed Count 1 and all of claims 43-79 of the '823 international application correspond substantially to proposed Count 2.

II. Explanation Why Interference Should Be Declared (37 C.F.R. §1.604(a)(3))

The present interference should be declared because the claims of the present application and the claims of the '233 and '193 applications or any application which is the

national stage of the '823 international application define the same patentable invention as either Count 1 or Count 2 proposed herein. Accordingly, there is interfering subject matter. 37 C.F.R. §1.601(i) states:

An interference may be declared between two or more pending applications naming different inventors when, in the opinion of the examiner, the applications contain claims for the same patentable invention.

The claims of the applications of the two parties are so closely related that the invention described in the present application is the same as (35 U.S.C. § 102) or obvious (35 U.S.C. § 103) in view of the invention of the '233 and/or '193 applications, assuming that the latter is prior art with respect to the former, and vice versa. Thus, the claims of the applications of the two parties are for the same patentable invention in accordance with 37 C.F.R. §1.601(n).

It should be noted that the present application is a continuation-in-part of application 09/345,495 (the '495 application), filed June 30, 1999, which application is now issued as U.S. patent 6,210,432 (the '432 patent). It is apparent from the issuance of the claims in the '432 patent that the present claims define patentable subject matter, as the claims in the patent are closely related to the claims of the present application that have been designated as corresponding to the count.

As the present application is a continuation-in-part of the '495 application, and as the claims of the present specification designated as corresponding to the counts, are based on portions of the present specification which are common to the present application and the parent application, such claims are entitled to the effective priority date of the '495 application. Accordingly, the priority date to which claims 22 and 53 are entitled is June 30, 1999, long prior to the filing date of the '233 application or the effective filing date of the '193 application or any application filed as the national stage of the '823 international application. Thus, when an interference is declared, the present applicants should be designated as the Senior Party.

III. Statement Under 37 C.F.R. §1.604(b)

On October 19, 2001, applicants filed a preliminary amendment submitting new claims 21-74. At the time that such amendment was filed, applicants inadvertently failed to comply with 37 C.F.R. §1.604(b). This inadvertant error is hereby corrected. Claims 21-74 submitted in applicants' preliminary amendment of October 19, 2001, were copied from the '823 international application for the purpose of provoking an interference between the present application and the '233 application, which is the priority application upon which the '823 international application is based, the '193 application,

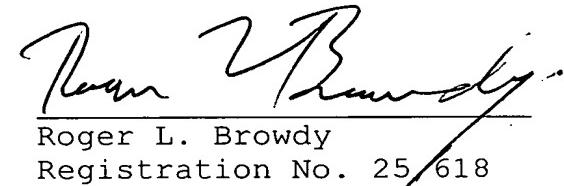
which is a divisional of the '233 application, and with any national stage application which has been filed with respect to the '823 international application or which will be filed in the future based thereon. Accordingly, it is urged that the inadvertant error by which the Examiner was not informed that the claims presented on October 19, 2001, define the same patentable invention claimed in a pending application of another be excused.

CONCLUSION

An early and favorable action declaring an interference between the present application and the '233 and '193 applications or any other application claiming the benefit thereof that is presently pending, or which is the national stage application of the '823 international application, or progeny thereof, and designating the present applicants as the Senior Party, are earnestly solicited.

Respectfully submitted,

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